

## **REMARKS**

### **Status of the Claims**

Claims 1-12 are pending. Claims 1-4, 6-10, and 12 have been amended herein. Claims 5 and 11 have been canceled. Amendments have been made primarily because the claims were drafted in forms appropriate for prosecution outside the U.S., so certain claims have been reformulated using conventional U.S. formats. Support for the amendments to claims 6 and 7 may be found, for example, at page 19, 3<sup>rd</sup> paragraph, of the original application documents. No new matter has been added by way of these amendments. Upon entry of this amendment, claims 1-4, 6-10, and 12 will be pending. Reconsideration of the claims as amended is respectfully requested.

### **Claim Objections**

The Examiner objected to claim 5-12 under 37 C.F.R. § 1.75(c) as improper multiple dependent claims. The multiple dependencies have been deleted by way of amendment. Withdrawal of the objections and examination on the merits is respectfully requested for these claims.

### **Rejections under 35 U.S.C. § 112, First and Second Paragraphs**

The Examiner rejected claims 1-4 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite and under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement, for the inclusion of the term “solvates” in claim 1. The term “solvates” has been deleted in the present amendments as redundant; it is well established that a claim to the compound per se covers the compound in all forms.

The Examiner also rejected claims 2-4 under § 112, second paragraph, for the recitation of the term “characterized.” The term “characterized” in claims 2-4 has been replaced with “whereby” to clarify that the description following the term is indeed a limitation.

The Examiner offers that claims 2 and 3 are indefinite as lacking antecedent basis for the term “alkyl” in the definition of R<sup>9</sup> substituents in claim 1 (from which they depend). Applicants disagree and point the Examiner to the last entry in the definition of R<sup>9</sup> in claim 1, which defines the substituent on the aryl or 1,3-benzodioxol-5-yl to include “optionally hydroxyl-substituted alkyl.”

As the hydroxyl substituent is optional, this term necessarily includes “alkyl” and thus provides basis for the “alkyl” terms in claims 2 and 3.

Finally, the Examiner argues the term “controlling” is indefinite, but this term does not appear in any of examined claims 1-4. To the extent the Examiner did examine claim 12, which is the only claim that recites this term, Applicant respectfully disagrees and argues the term “controlling” is clear. In light of the claims, the specification, and knowledge in the art, one of skill in the art would understand this term to mean “reducing viral growth.” Regardless of whether the goal of the method is prophylaxis, treatment, or both, “controlling” would thereby have the effect of alleviating present or potential symptoms. As the term “controlling” is therefore clear to one of skill in the art based on the claim language and the specification (see, e.g., pages 16-18), Applicant requests withdrawal of this rejection.

### **CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. 584212009400. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 7, 2011

Respectfully submitted,

Electronic signature: /Katharine E. McElhone /  
Katharine E. McElhone  
Registration No.: 57,462  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
Telephone: (858) 720-7997  
Facsimile: (858) 720-5125